

Application No.: 09/755,204

Docket No.: 59097US (30471)

REMARKS

Claims 82-95 are currently pending in the application. Of these, claims 82-94 stand rejected and claim 95 has been withdrawn from consideration.

Claims 84, 85, 89 and 94 are canceled without prejudice and without disclaimer. Claim 95, previously withdrawn from consideration, is canceled without prejudice and without disclaimer with the right to refile in a divisional application.

No new claims have been added. Accordingly, upon entry of the amendments herein presented, claims 82-83 and 86-88, and 90-93 will be pending.

The amendments to the claims are intended to focus the invention more clearly as a means to achieving improved bovine pregnancy rates and to remove the confusion in terminology presented previously in claim 1.

Claim 1 finds support throughout the specification, generally at page 29 where "The improved method for cloning a term animal employs nuclear transfer techniques and encompasses the steps of: (a) inserting a somatic cell, or nucleus isolated from said somatic cell, deriving from a somatic cell culture having undergone 5 or more passages, into an enucleate oocyte to form a cybrid; (b) optionally activating the cybrid; (c) culturing the cybrid; (d) transferring the cybrid of step (c) into an appropriate host such that the cybrid develops into a fetus..."

More particularly, as claimed in claim 1, Applicants point to page 39 and Table 4. At line 16, the text states "Overall, a higher pregnancy and calving rate from embryos derived from cells at passage 10(64 and 29%) than from those at passage 15..." Applicants intended claim 1 to reflect this procedure, which is based on "serum starvation" (page 39, line 8) of adult somatic cells after prolonged culture [of] skin fibroblast cells..." (page 38, lines 2-3).

Cancellation of the claims is in no way to be construed as acquiescence to any of the rejections raised by the Action and is done solely to expedite prosecution of the application. Applicants reserve the right to pursue the claims filed in this application in one or more separate applications.

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Double Patenting

Applicant acknowledges the Examiner's withdrawal of the double patenting rejection previously applied to now canceled claims and recognition that the currently pending claims are distinguished.

Claim rejections under U.S.C. § 112, First Paragraph

Claims 82-94 were rejected under 35 U.S.C. 112, first paragraph as allegedly not reasonably enabled for trans-species nuclear transfer, while admittedly enabled for nuclear transfer between donor cell and recipient oocytes of the same species.

In the interest only of expediting prosecution and not necessarily concurring with the rejection, Applicants have defined the donor and recipient as from the same species.

Additionally, the Action rejected claims 82-95 under 35 U.S.C. 112, first paragraph, as not sufficiently described to reasonably convey that the inventors were in possession of the invention at the time the application was filed. In particular, the Examiner alleges that "...there is no evidence that these examples would extend beyond the species tested." Additionally, the Examiner notes that "...each of the working examples using the claimed method in only one specific species of animal fail to provide an efficiency of 64%." In summary, it appears that the examiner is taking the position that new matter has been added because what is claimed is not described in the application.

Applicants note that they have indeed demonstrated a 64% pregnancy rate (please refer to references previously made to page 39 of the application). The new amendment to claim 1 more clearly associates this number with about 10 passages.

Applicants have also amended claim 1 to focus on results obtained with bovines and otherwise to remove the confusion introduced previously by not directly tracking the description in the specification.

The additional amendments made in consideration of the Advisory Action are believed to address the issues raised. Applicants do not believe that an additional burden will be imposed on the Examiner.

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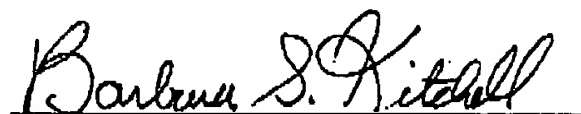
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CONCLUSION

Applicants believe that all formalities have been complied with and a complete response has been submitted. It is respectfully submitted that this application is now in condition for allowance with claims 82-83, 86-88, and 90-93. Should any issues remain or should the Examiner believe that a telephone conference with Applicants' attorney would be helpful in expediting prosecution of this application, the Examiner is invited to contact the undersigned at the telephone number shown below.

Respectfully Submitted,

Date: March 15, 2005



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